REMARKS

Claims 2-27 and 29-58 are pending. Claims 7 and 34 were amended as discussed below. Claims 8 and 35 were amended conform to the amendments in claims 7 and 34, respectively. New claims 57-58 were added.

No new matter was added by any of the amendments. The revised language in step (a) of claims 1 and 7 is clearly supported by at least the following portions of the original specification:

1. Paragraphs [0039] through [0041] on pages 10-11 (e.g., In a Network Source version of the Active-Learning Algorithm, the sets of network configuration settings are provided by the remote server at run time based on the network connection type of the client machine. (paragraph [0039]); "In a Preset version of the Active-Learning Support Algorithm, the responsibility of the remote server is to provide a set of network configuration settings to a client machine." (paragraph [0040]).

2. Fig. 1 and paragraphs [00022], [00024], [00026] and [00028] on pages 4-7 of the original specification which illustrate and describe that the network configuration settings 135 are to be used by the user's client machine 120.

Regarding new claims 57-58, the step of "determining a plurality of groups of network configuration settings to be used by the user's client machine…" is clearly supported by at least paragraph [00033] on page 8 of the specification (e.g., "…future groups of network configuration settings to test are determined by either using a predetermined test sequence supplied locally in a client program running on client machine 115, or via the remote server 105…).

Withdrawal of all outstanding rejections is respectfully requested for at least the reasons set forth below.

Examiner Interview

Applicants wish to thank Examiner Gold for extending the courtesy of a telephone interview with Applicants' undersigned representative on May 26, 2009. During the interview, the contents of a previously faxed draft response and draft Declaration of Prior Invention…" was discussed. The following specific items were discussed:

1. Regarding the outstanding rejection under 35 U.S.C. § 112, second paragraph, the Examiner agreed that the claim amendments and corresponding arguments overcome this rejection.

2. Regarding the outstanding rejection under 35 U.S.C. § 101, no agreement was reached regarding the disposition of this rejection. The Examiner will review the existing preamble language of claim 34 in view of the USPTO's latest guidelines regarding acceptable preamble language, and will recommend appropriate language revisions, if necessary. Paragraph [00054] of the original specification was discussed as providing support for minor preamble wording revisions. Applicants' undersigned representative stated that he is agreeable to such minor language amendments, if necessary.

3. Regarding the "Declaration of Prior Invention...", the Examiner stated that upon initial review, the Declaration appears to include all of the relevant information necessary to swear behind Claessens et al., and thus overcome the outstanding prior art rejections, but that a more detailed review will need to be made before a final decision can be made on whether it overcomes the prior art rejection. The Examiner questioned whether the dependent claims must be treated in the declaration. Applicant argued that it should not be necessary to address the dependent claims because overcoming the independent claims would preclude the combination of references from being applied to any of the dependent claims in the same manner as substantively overcoming an independent claim would necessarily automatically overcome the dependent claims. Applicant further notes that MPEP 715.02 and 715.03 discusses the breadth of the showing when genus-species issues are present, but that the present set of claims does not present any such issues.

4. Regarding the outstanding rejection under 35 U.S.C. § 103, this rejection was not discussed, and would be deemed moot upon acceptance of the "Declaration of Prior Invention..." Applicants refer the Examiner to the arguments below, noting especially the arguments on pages 17-19 that the combination of Claessens in view of Rehkopf **does not meet any of the six recited steps** of the independent claims.

5. Applicant agreed to formally file the draft papers for formal entry and consideration by the Examiner.

35 U.S.C. § 101 rejection

The article of manufacture claims were rejected under 35 U.S.C. § 101 as allegedly being directed to software, per se, and thus were deemed to be non-statutory. Applicants respectfully traverse this rejection.

Applicants are not aware of any case law holding that article of manufacture claims of the type recited in the present application are non-statutory, nor has the Examiner cited any such case law. These claims are directed to the statutory class of invention of <u>manufacture</u> (i.e., a "computer program product," also referred to as "an article of manufacture"). The "Beauregard" format of these claims is explicitly permitted by the USPTO and should be treated as statutory <u>product claims</u>, as discussed in MPEP 2106.01, submitted in Appendix B of the Supplemental Amendment filed on December 12, 2009 (hereafter, "the previous response"), and in *Ex parte Bo Li*, Appeal 2008-1213 (USPTO BPAI 2008, November 6, 2008), submitted in Appendix C of the previous response. MPEP 2106.01 reads, in part, as follows (underlining added for emphasis):

> ...a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and <u>is thus statutory</u>. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035...
>
> ...When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a <u>product claim</u>.

Applicants highlighted this case law and USPTO guidelines in the paragraph numbered 6 on page 11 of the previous response. However, the outstanding rejection does not include any discussion or rebuttal of either the case law or the USPTO guidelines.

In sum, the article of manufacture claims are believed to be statutory and thus withdrawal of this rejection is respectfully requested.

35 U.S.C. § 112, second paragraph, rejection

In the outstanding Office Action, the Examiner asserts that step (a) of claims 7 and 34 in which a plurality of groups of network configuration settings are "defined for the user's client machine" is not found in the specification, and that the specification only discloses "choosing predefined configuration settings for a client machine, not defining them." In response, this phrase was amended to recite that the settings are "provided...to be used by the user's client machine," as explicitly described in the original specification. Preferred embodiment wherein the settings are first determined (the determined settings thereby becoming the provided settings) is now recited in new claims 57 and 58.

The Examiner further asserts that there is no disclosure of the previously added negative limitation, citing MPEP 2173.05(i). In the previous response, Applicants argued that MPEP 2173.05(i) explicitly permits a negative limitation of the type added by Applicants. The outstanding rejection does not provide any discussion or rebuttal of Applicants' arguments, or why MPEP 2173.05(i) does not permit the type of negative limitation added by Applicant. Notwithstanding these facts, and to advance prosecution of the application, the negative limitation was deleted in the present amendment since it is believed to be redundant to the feature wherein step (c) is "initiated on the user's client machine." This feature was added to patentably distinguish over Claesens which <u>initiates</u> selection of, and changes to, network-related parameters on the network, and not on any client machine connected to the network.

The Examiner's rejection of the repeating step (e) is believed to be moot in view of the amendment to step (c). However, if the Examiner's position is that there is no disclosure of repeating performance tests for other selected groups of settings, then this position is respectfully traversed. This feature is described throughout the original specification, such as in Figs. 2 (e.g., there is a test result for each group of network settings), Fig. 3 (esp. step 315), Fig. 4, and paragraphs [00029] and [00030].

Accordingly, withdrawal of this rejection is respectfully requested.

Prior Art Rejections

Claims 2-3, 5-12, 14, 18, 23, 26, 27, 29-30, 32-39, 41, 45, 50, 53-56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Claessens et al. (hereafter, "Claessens") in view of Rehkopf.

Claims 4 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Claessens et al. in view of Rehkopf and Official Notice.

Claims 13 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Claeseens in view of Rehkopf and further in view of Easty et al. (hereafter, "Easty").

These rejections are respectfully traversed for at least the reasons set forth below.

1. Claessens

Claessens discloses a system and method for network performance testing. This has nothing to do with the claimed invention which relates to optimizing network configuration settings for a user's client machine, not a network, by adjusting network configuration settings of the user's client machine. Claessens does not even discuss any element equivalent to a user client machine that is configured to have its network configuration settings adjusted. At best, column 7, line 65 through column 8, line 14 of Claessens discusses a web server/user interface 310 that functions to control the network performance testing. However, no adjustments are made to the network configuration settings of the user interface device 310. Thus, Claessens is not relevant to the claimed invention and fails to disclose or suggest any of the claimed steps.

As highlighted by the Examiner, Claessens discloses test configuration data and stores a plurality of different test configurations. As discussed on column 10, lines 15-24 of Claessens, each test configuration has a predetermined identifier that is associated with network-related parameters such as a predetermined packet rate, packet size, test duration, packet generators, packet receivers and one or more devices to be tested. As further discussed in column 10, lines 33-60 of Claessens, a system administrator selects one of the plurality of test configuration identifiers. The network is then configured based on the network-related parameters associated with that identifier, and a network performance test is conducted using the configured network. Thus, at best, Claessens discloses providing a plurality of groups of network-related parameters

for <u>configuring a network</u>. In contrast to Claessens, the claimed invention recites providing a plurality of groups of network configuration settings for a <u>user's client machine</u>.

The Examiner admits that Claessens does not disclose steps (d) or (e) of claims 7 and 34. Applicants further add that Claessens also does not disclose step (f) of claims 7 and 34.

2. Rehkopf

Rehkopf discloses a method for benchmarking and optimizing end-to-end processing performance of a computer network system. The method operates as follows:

a. System performance variables are selected.

b. A baseline performance test is run using an initial set of values for the system performance variables to produce a benchmark system performance.

c. The system performance variables are fixed at the initial set of values.

d. A floating variable is selected from among the system performance variables.

e. Subsequent tests are run with the floating variable set to different values, and system performance indicators that result from each subsequent test are recorded. The system performance indicators are compared to the benchmark system performance. An <u>optimal value of the floating variable</u> is then recorded that optimizes the system performance indicators.

f. Another floating variable is then selected from among remaining system performance variables that have not yet been selected to be the floating variable.

g. Steps (e) and (f) are repeated until all of the system performance variables have been selected as the floating variable.

h. Each of the system performance variables are then fixed to its optimal value.

Rehkopf's method can be characterized as a "brute force" method in that each system performance variable is individually tested while keeping the other system performance variables constant. (The system performance variable being tested during each iteration is the "floating variable.")

Rehkopf's method has at least the following disadvantages:

a. The test process may take a long amount of time because each system performance variable must be individually tested throughout its entire potential range of values. If there are a large number of system performance variables, the test time may be extremely long.

b. After each system performance variable is individually tested, its "optimal value" is determined only in view of the <u>initial values</u> of the other system performance variables (which remain fixed at their initial values during the testing). However, it is very common that certain system performance variables affect other system performance variables. Thus, each system performance variable may actually have a better (i.e., more optimal) value if one or more of the other system performance variables were set to a value <u>other than their initial values</u>. Rehkopf's method has no process for determining the best <u>set</u> of system performance variables.

c. No prior knowledge of previously determined optimal system performance variables is used in Rehkopf. Such knowledge could potentially speed up the testing process by reducing or eliminating the number of system performance variables that would need to be tested, or by reducing the range of values to be tested for the current floating variable.

3. <u>Patentability of amended independent claims 7 and 34 over Claessens in view of Rehkopf</u>

Claim 7 reads as follows:

> 7. A method of optimizing network configuration settings for a user's client machine, the method comprising:
> (a) providing a plurality of groups of network configuration settings to be used by the user's client machine;
> (b) establishing a network connection between the user's client machine and a remote server;
> (c) selecting one of the groups of network configuration settings to be used by the user's client machine from the provided groups of settings, wherein step (c) is initiated on the user's client machine;
> (d) automatically conducting one or more performance tests using the selected network configuration settings during the established network connection;
> (e) repeating steps (c) and (d) for one or more other groups of network configuration settings during the established network connection; and
> (f) automatically adjusting the network configuration settings of the user's client machine provided in the groups based on the results of the performance tests, wherein the adjusted network configuration settings are settings that optimize the performance of the user's client machine.

The combination of Claessens in view of Rehkopf does not meet any of the six recited steps.

In the outstanding Office Action, the Examiner asserts that steps (a)-(c) are met by Claessens. However, as discussed above, Claessens relates to <u>network</u> performance testing which has nothing to do with the claimed invention which relates to optimizing network configuration settings for a <u>user's client machine</u>, not a network, by adjusting network configuration settings of the user's client machine. Accordingly, steps (a)-(c) are not disclosed in Claessens.

Furthermore, even if Claessens was modified in view of Rehkopf as suggested by the Examiner, the resultant modified Claessens would still lack <u>all</u> of the steps in claim 7.

In the outstanding Office Action, the Examiner relies upon Rehkopf as disclosing concepts similar to steps (d) and (e) of claims 7 and 34, and asserts that it would have been obvious to modify Claessens to incorporate the features of these steps. That is, the Examiner's position appears to be that it would have been obvious to modify Claessens to conduct one or more additional network performance tests using parameters from <u>different</u> groups of network-related parameters for configuring a network (i.e., different test configuration identifiers) in Claessens). Applicants respectfully traverse this position.

First, Rehkopf does not disclose selecting a <u>different group</u> of performance variables. In the iterative step (g) of Rehkopf discussed in section 2 above, another floating variable is selected from among remaining system performance variables that have not yet been selected to be the floating variable, and the remaining variables are set or reset to their initial values. If the initial set of values (or a subset of the initial set of values) is considered to be equivalent to the claimed group of network configuration settings, at best, Rehkopf discloses providing only <u>one</u> group of network configuration settings. Rehkopf always reverts back to the <u>same</u> initial set of values (i.e., the same group of network configuration settings) every time that the floating variable is changed. Thus, the concept of <u>providing</u> a <u>plurality</u> of groups of network configuration settings and conducting performance tests on the different groups of provided network configuration settings is completely absent from Rehkopf.

At best, modifying Claessens in view of Rehkopf would result in performing network performance tests by modifying only one of the parameters associated with the one selected test configuration identifier (Claessens only selects <u>one</u> test configuration identifier), and then repeating the network performance tests by modifying another (different) parameter in the one selected test configuration identifier. For example, the first test may vary the packet rate and the

second test may vary the packet size. The parameters that are not being modified would remain at their initial values, exactly as disclosed by Rehkopf. There is simply nothing in Rehkopf to suggest modifying Claessens so that a <u>different test configuration identifier</u> (and thus a different group of parameters) would be selected for subsequent testing.

Stated simply, Rehkopf does not disclose the concept of conducting subsequent performance tests using a <u>different group of settings</u>. Therefore, Rehkopf cannot make up for the above-noted deficiencies in Claessens and thus even if Claessens was modified as suggested by the Examiner, the resultant modified Claessens would still lack at least the above-highlighted features in steps (d) and (e), as well as step (f) of claim 7. To summarize, Applicants are not asserting that Claessens cannot be modified based on disclosures in Rehkopf. Instead, Applicants are asserting that the modifications suggested by Rehkopf would not lead to Applicant's claimed invention.

Second, Claessens relates to <u>network</u> performance testing which has nothing to do with the claimed invention which relates to optimizing network configuration settings for a <u>user's client machine</u>, not a network, by adjusting network configuration settings of the user's client machine. Thus, even if Claessens was modified in view of Rehkopf as proposed by the Examiner, the resultant modified Claessens would still not meet **any** of the claimed steps which all relate to network configuration settings of a user's client machine. Furthermore, even if Claessens was modified in view of Rehkopf to cause the selection of a <u>different test configuration identifier</u> (and thus a different group of parameters) for subsequent testing, the resultant modified Claessens would still not meet any of the claimed steps which all relate to network configuration settings of a user's client machine. Of course, Applicants do not believe that this latter modification is suggested by the references, but this point illustrates just how different the applied references are from the claimed invention.

Claim 34 is believed to be patentable over Claessens in view of Rehkopf for the same reasons as claim 7.

4. <u>Patentability of dependent claims 13 and 40 over Claessens in view of Rehkopf and Easty</u>

Claim 13 reads as follows (underlining added for emphasis):

13. The method of claim 7 further comprising:
(g) storing on the remote server, groups of <u>network configuration settings</u> and <u>aggregate test results</u> associated with <u>other</u> client machines that previously established a network connection with the remote server; and
(h) the user's client machine receiving groups of network configuration setting <u>recommendations</u> from the remote server based on the groups of <u>network configuration settings</u> and the <u>aggregate test results</u> stored on the remote server.

<u>Easty</u> relates to aggregating past <u>content</u> selections of users so as to configure an endpoint server with content that is most likely to be requested. The scheme in Easty operates as follows:

a. Information received from users are analyzed to generate an "aggregate profile of the endpoint server." The "aggregate profile of the endpoint server" represents the collective characteristics and preferences of a plurality of users served by the endpoint server. For example, the preferences may be defined by the frequency that a particular content item or type of content is requested (column 3, lines 2-4).

b. The central server selects a subset of master contents stored in a central database based on an analysis of the aggregate profile of the endpoint server.

c. The selected subset of the master contents is stored in the endpoint database for distribution to the users.

Using aggregation concepts for <u>content selection queuing</u> is a completely different and non-analogous concept than using aggregation concepts for <u>selecting network configuration settings</u>. That is, Easty is directed to content selection, whereas the present invention is directed to network configuration setting selection. Easty is not directed to the same problem in the art addressed by the present invention, nor is Easty in the same field of endeavor as the present invention. Easty is thus non-analogous prior art and therefore cannot be combined with <u>Claessens</u> or Rehkopf to provide the missing limitations in Claessens and Rehkopf related to aggregate test results and the use of such results to receive recommendations for network configuration settings.

Claims 13 and 40 further recite that a remote server stores network configuration settings and aggregates test results associated with <u>other</u> client machines that previously established a network connection with the remote server, and that a user's client machine receives network configuration setting <u>recommendations</u> from the remote server, based on the network

configuration settings and the <u>aggregate test results</u> stored on the remote server. No such limitation is even remotely disclosed or suggested in Claessens or Rehkopf.

In the Office Action dated July 9, 2008, the Examiner admits that Claessens and Rehkopf lack these limitations and relies upon Easty for such limitations. However, as discussed above, Easty is directed to a completely different invention, and is non-analogous prior art, and thus cannot be combined with Claessens or Rehkopf to make up for the deficiencies in these references.

In section 8 on page 11 of the Office Action dated May 2, 2007, the Examiner responded that Rehkopf and Easty are analogous prior art because both relate to "data transferred over a network." While the Examiner has properly identified the well-known test for "analogous art," the Examiner's explanation that both relate to "data transferred over a network" is an overly broad characterization of the references that bears no relationship to the claim limitation that led the Examiner to rely upon Easty. Millions of prior art references relate to "data transferred over a network." However, having this fact in common does not provide sufficient motivation to identify all such references as being analogous art for purposes of combining such references to meet any limitations in a claim, including limitations that do not relate to network data communications. The Examiner's reasoning is no different in nature than arguing that all references that have "computers" or "memory" in them are analogous art, and thus are properly combinable to meet claim limitations that have nothing to do with computers or memory.

5. Patentability of remaining dependent claims

The remaining dependent claims are believed to be patentable over the applied references for at least the reason that they are dependent upon allowable base claims and because they recite additional patentable elements and steps.

6. Applicants' comments regarding Examiner's Response to Arguments

The outstanding prior art rejections are identical to those given in the previous Office Action. The rationales for the rejections are substantially identical. Thus, the arguments above are substantially repeated from the previous response and the Amendment filed October 29, 2008, except that the arguments refer to the currently amended claim language.

Applicants respectfully request that the Examiner reconsider the arguments above because **Claessens in view of Rehkopf does not meet *any* of the six recited steps of the independent claims 7 and 34, and Claessens in view of Rehkopf and Easty does not meet *any* of the additional two recited steps of dependent claims 13 and 40.** It is clearly erroneous to maintain a rejection that does not even meet one step of a claimed process, especially when there are at six to eight recited steps.

Furthermore, the response to Applicants' arguments provided on paragraphs 9-11 of the outstanding rejection does not provide any substantive explanation of why Applicants' arguments are not persuasive.

In paragraph 9, the Examiner states that Applicants are attacking the references individually where the rejections are based on combinations of references. Applicants respectfully disagree with this characterization of the arguments. Applicants' arguments exactly track the manner in which the references were <u>applied by the Examiner</u>. In fact, Applicants stated above that they are not asserting that Claessens cannot be modified based on disclosures in Rehkopf, but instead are asserting that the modifications suggested by Rehkopf would not lead to the claimed invention. This is not an attack on the references individually where the rejections are based on combinations of references.

In paragraph 10, the Examiner cites well-established case law to rebut Applicants' argument that there is no suggestion to combine the references. As noted above, no such argument was made with respect to the independent claims 7 and 34 since Applicants conceded that Claessens could be modified based on disclosures in Rehkopf. Applicants' argument is that the modification would not have resulted in the claimed invention.

In paragraph 11, regarding dependent claims 13 and 40, Applicants still believe that Easty is directed to a completely different invention, and is non-analogous prior art, and thus cannot be combined with Claessens or Rehkopf to make up for the deficiencies in these references. Applicants presented a detailed explanation of their position in previous responses (repeated above), and no rebuttal has been provided to date of that explanation. In fact, the detailed explanation addressed why Easty fails to meet either of the prongs of the test for analogous art set forth in *In re Oetiker* cited by the Examiner.

In paragraph 11, the Examiner further states that Easty is analogous art because it relates to user settings/preferences. However, this is an overly broad characterization of Easty that bears

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no relationship to the claim limitation that led the Examiner to rely upon Easty. Millions of prior art references relate to "user settings/preferences." However, having this fact in common does not provide sufficient motivation to identify all such references as being analogous art for purposes of combining such references to meet any limitations in a claim. The Examiner's reasoning is no different in nature than arguing that all references that have "computers" or "memory" in them are analogous art, and thus are properly combinable to meet claim limitations that have nothing to do with computers or memory. Here, claim 13 is not merely adding user settings/preferences to independent claim 7.

In sum, the response to arguments in the outstanding rejection fail to properly rebut Applicants' arguments for patentability.

7. Applicants' concurrently filed "Declaration of Prior Invention..." under 37 C.F.R. § 1.131 overcomes the outstanding rejection

All of the grounds of the outstanding rejection include Claessens. Claessens has a filing date of February 28, 2001 which is prior to the February 19, 2002 filing date of the present application and also prior to the priority document of the present application, namely, U.S. Provisional Application No. 60/277,463 filed on March 21, 2001. However, the invention set forth in the present application was conceived prior to February 28, 2001 as established in the concurrently filed "Declaration of Prior Invention..." under 37 C.F.R. § 1.131 (hereafter, "the Declaration"), and due diligence from prior to February 28, 2001 to the effective filing date of the present application (constructive reduction to practice), which is March 21, 2001 (the filing date of U.S. Provisional Application No. 60/277,463) is also established in the Declaration. A summary of the events established in the Declaration is provided as follows:

1. On February 15, 2001, which is prior to the effective filing date of Claessens, a technical disclosure (Exhibit 1) was created that contained sufficient evidence of conception of the presently claimed invention, as shown in the claim chart of Exhibit 4.

2. Due diligence towards a constructive reduction to practice began at least as early as February 22, 2001, which is also prior to the effective filing date of Claessens, when the invention disclosure was forwarded to Applicants' undersigned representative.

3. Due diligence towards a constructive reduction to practice continued throughout March 2001, culminating in the filing of U.S. Provisional Application No. 60/277,463 on March 21, 2009.

Furthermore, since U.S. Provisional Application No. 60/277,463 includes all of the disclosure items of Exhibit 1 that were highlighted in Exhibit 4, the present application is entitled to the priority date of the provisional application.

The evidentiary materials provided in the Declaration are fully compliant with the requirements of MPEP 715 for a showing of a "prior invention" (swearing back of a reference). More specifically, the evidentiary materials provide a showing of facts of "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice)," as discussed in MPEP 715.07, Part III, paragraph (C) and MPEP 715.07(a), attached hereto as an Appendix.

Accordingly, withdrawal of all outstanding prior art rejections is respectfully requested regardless of whether the arguments presented in sections 1-6 above are persuasive in overcoming the prior art rejections.
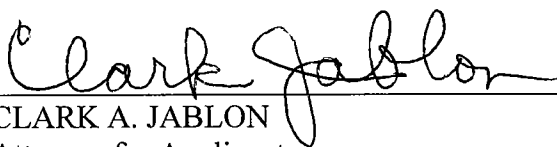
Conclusion

Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. Issuance of a Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

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(Date)

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